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**REMARKS**

Entry of this Amendment is proper because it does not raise any new issues requiring further search by the Examiner, narrows the issues on appeal, and is believed to place the present application in condition for immediate allowance.

Claims 1-22 are all the claims presently pending in the application.

Claims 18-22 have been amended merely to correct minor grammatical errors (i.e., proper capitalization of the first word of the claim).

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-5, 13, 14, 18, and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zhang (U.S. Patent No. 6,354,630) in view of Gasper, et al. (U.S. Patent No. 5,919,730).

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang in view of Gasper, in further view of Bouldin (U.S. Patent No. 4,837,134), in further view of Dickerson (U.S. Patent No. 5,633,126).

Claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zhang in view of Gasper, in further view of Yano, et al. (U.S. Patent No. 6,035,308).

Claims 9-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zhang in view of Gasper, in further view of Cass, et al. (U.S. Patent No. 5,946,414).

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Claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Zhang in view of Gasper, in further view of Cass, and further in view of Hayashi, et al. (U.S. Application Publication No. 2003/016149A1).

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Boswell (U.S. Patent No. 5,559,933) in view of Zhang, in further view of Gasper.

Claims 16 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Boswell in view of Zhang, in further view of Gasper, and further in view of Ur (U.S. Patent No. 5,568,550).

Claims 20-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang in view of Gasper, and further in view of Ur.

These rejections are respectfully traversed in the following discussion.

#### **I. THE CLAIMED INVENTION**

The present invention relates to an invisible information recording method for recording an image being different from a visually perceived image on a part of a sheet of a paper on which an image is recorded, and an image forming apparatus using the same. Further, the invention relates to a printing system which easily retrieves the already printed document data from a part of a printed document formed by the image forming apparatus.

In related art methods and systems for embedding information, a diameter of each dot is typically 0.1 mm. However, a dot of this size is visible, which is not desirable. On the other hand, in the related art methods and systems, when invisible, isolated micro dots are embedded into the image, the recording reliability is deteriorated.

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Thus, the related art methods and systems have problems in that, as the result of embedding the additional information, the image quality is deteriorated, it is difficult to read out the embedded information, and/or, when micro dots that cannot be perceived are printed, the reliability is unsatisfactory (e.g., see specification at page 3, lines 13-25, and page 4, line 1; see also page 4, lines 15-21).

The claimed invention, on the other hand, provides an image forming method and apparatus which is capable of embedding a large amount of additional information in an image in an invisible fashion and without deteriorating the image quality (e.g., see specification at page 5, lines 21-24).

According to the novel and unobvious exemplary aspects of the present invention, large amount of information different from an image visually perceived can be embedded so as to be invisible to the naked eye by utilizing blank areas on a recording sheet of paper. In other words, a lot of additional information can be embedded into a visible image by assigning information items, e.g., characters and symbols, to a plurality of patterns each consisting of dots invisible to the naked eye, which are distributed to such an extent that a variation of densities of the distributed dots cannot be visually perceived by the naked eye (e.g., see specification at page 6, lines 8-17).

For example, in the exemplary aspect of the invention illustrated in Figure 5, a blank area extraction part 32 extracts a blank area or blank areas from the print page image. Ideally, it extracts a plurality of rectangular blanks from the page image. The information 33 is prepared, which is different from the image to be printed, i.e., the image visually perceived. The information may contain detailed attributes of the printed page, file storing locations, author of the document, page correction history, and others. The information 33 different from the perceived image is converted into an invisible pattern as

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exemplarily shown in Figure 2, by the invisible pattern conversion part 34. The converted invisible pattern is combined with the blank areas extracted by the blank area extraction part 32, and the resultant data is output to the printer 36 (e.g., see specification at page 15, lines 3-15).

## II. THE CITED REFERENCES

### A. Zhang

Zhang relates to a method for encoding, on an imprintable medium, identification information for identifying the imprintable medium in a manner detectable by a print-monitoring system includes the steps of defining an identification pattern. The identification pattern is imprinted on a print control region so as to be relatively inconspicuous to an unaided human reviewer of the printed matter while remaining detectable to a print monitoring system. The method includes the step of imprinting, at a plurality of locations in the print control region, a plurality of bit characters detectable by the print control system. The spatial distribution of the bit characters encodes information about the identity of the document.

### B. Gasper, et al.

Gasper relates to media for restricting copying of a document utilizing one or more microdots that are embedded in the document for providing a non-visual, but machine detectable mark or marks. The detected means for detecting the presence of one or more microdots in the document inhibits a copy machine from copying the document (e.g., see Gasper at Abstract).

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### **C. Bouldin**

Bouldin relates to a data card for optical information featuring a gelatin layer having a thin black crust at the top of the layer. The crust is formed by developed black irregular oblong silver particles within the top 0.5 micron of the gelatin colloid matrix. The remainder of the colloid matrix is substantially clear gelatin and a reflective metallic layer is disposed below the gelatin. The strip is laminated into a wallet-size card and may be pre-patterned during formation of the crust with control indicia or pre-recorded data. User data may be recorded by modifying the black silver particles in the crust with a laser to expose the reflective underlayer. A laser or other light source is used to read data on the medium with optical contrast between the black surface metallic layer underlying the gelatin layer which can be observed in the recorded spots.

### **D. Dickerson**

Dickerson relates to a radiation-sensitive silver halide film for reproducing digitally stored medical diagnostic images through a series of laterally offset exposures by a controlled radiation source followed by processing in 90 seconds or less, including development, fixing and drying. The film exhibits an average contrast in the range of from 1.5 to 2.0, measured over a density above fog of from 0.25 to 2.0. An emulsion layer is provided in which silver bromochloride grains (a) comprised of at least 10 mole percent bromide, based on silver, (b) having a mean equivalent circular diameter of less than 0.40  $\mu\text{m}$ , (c) exhibiting an average aspect ratio of less than 1.3, and (d) coated at a silver coverage of less than 40  $\text{mg}/\text{dm}^2$ . Adsorbed to the surfaces of the silver bromochloride grains at least one spectral sensitizing dye having an absorption half peak bandwidth in the spectral region of exposure by the controlled exposure source. The film contains an infrared opacifying dye that is capable of reducing specular transmission

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through the film before, during and after processing to less than 50 percent, measured at a wavelength within the spectral region of from 850 to 1100 nm. The film contains a magnetic recording layer which provides a positive  $b^*$  value influence that is more than offset by the negative  $b^*$  value influence of the silver bromochloride emulsion, allowing magnetic recording layer integration into the film while achieving favorable image tone and minimum density characteristics.

**E. Yano, et al.**

Yano relates to a document data administrating system including a filing means for previously storing data related to particular words, texts, symbols, or graphics as related data files. The system includes medium paper including at least one piece of description data, linking data, and selection data. The system further includes a reading means for reading out selection data and linking data from the medium data, a searching means for searching corresponding related data files from the filing means according to the selection data and linking data each read out by the reading means, and an outputting means for outputting the related data files each searched by the searching means (e.g., see Yano at Abstract).

Yano discloses recording data in code areas (linking data, related data, and other data) with invisible ink or toner each readable in invisible rays such as ultraviolet rays and infrared rays. Yano asserts that visibility (readability) of data as a document for Inper (e.g., Interact paper, medium paper, etc.), can further be improved. Also, Yano asserts that the Inper can be handled on its appearance in the same manner as an ordinary document can be, and disposable Inpers can also be used for memos or the like, which allegedly makes it possible to effectively utilize paper resources (e.g., see Yano at column 33, lines 53-67).

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**F. Cass, et al.**

Cass relates to message values included in a set of valid message values that constitute a coding scheme and which each encoded in an image region, called an encoded signal block, composed of a spatially arranged pattern of colored sub-regions (e.g., see Cass at Abstract; see also column 6, lines 42-46).

Cass discloses that the colored sub-regions have color values produced by modulating a reference color value by a color change quantity expressed as a color space direction in a multi-dimensional color space such that the average color of all of the sub-region colors is the reference color. There is a unique pattern of color-modulated sub-regions for each valid message value in the coding scheme.

In one embodiment, the color space direction is computed to be simultaneously detectable by a digital image capture device such as a scanner and substantially imperceptible to a human viewer, so that the embedded data represented by the pattern of color modulations are visually imperceptible in the encoded signal block.

When the reference color is determined to be the average color of an image region in an original color image, the encoded signal block may replace the image region in the original image, producing an encoded image version of the original image having little or no image degradation. The original image colors become carriers of the encoded data. Signal blocks may be arranged to encode data in only one dimension in an image, which allows for less complex decoding algorithms, or in a two dimensional array or grid-like structure, which allows for a high encoded data density rate.

Cass discloses that its image encoding technique is motivated by the need to reliably encode information at a high density rate in an image, and in particular in graphic

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or photographic images, without any perceived image degradation or distortion (e.g., see column 6, lines 42-46).

**G. Hayashi, et al.**

Hayashi relates to a technique for embedding digital-watermark information in image data while minimizing deterioration of the original image quality. Hayashi discloses a data processing apparatus having input means for inputting image data consisting of a plurality of coefficients, and embedding means for embedding digital-watermark information in coefficients having values falling within a predetermined range of the input image data (e.g., see Hayashi at Abstract).

**H. Boswell**

Boswell relates to a system and method for transferring and printing files originating on mainframe computer systems, workstations, or personal computers connected within a heterogeneous computer network is disclosed. The printer controller coordinates the distribution of print files across multiple computer systems to attached printers for printing.

In response to incoming files received from another computer system within the network, Boswell's system utilizes file mask attributes to automatically generate transfer requests and print requests. In response to user inputs through a graphical user interface, Boswell's system updates various file databases, print attribute and transfer attribute libraries, and system configurations before generating a transfer or print request. Support for multiple page description languages and multiple printers is provided (e.g., see Boswell as Abstract).

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### **I. Ur**

Ur relates to a method and system for identifying documents generated by an unauthorized software copy in which each copy of software is assigned a unique identifying code pattern which is printed on all documents produced with that software by a high resolution printer. The unique identifying code pattern is a plurality of spaced apart marks having a size no greater than about 300 dpi, and is therefore, at best, barely noticeable to the human observer.

Preferably, the unique identifying code is replicated multiple times over the document using an error correcting code to assure that at least one replication will be clear of matter selected for printing by the software. A high resolution scanner extracts and identifies the code patterns printed on the document.

### **III. THE PRIOR ART REJECTIONS**

#### **A. Claims 1-5, 13, 14, 18, and 19:**

Claims 1-5, 13, 14, 18, and 19 stand rejected under 35 U.S.C. §103(a) as being anticipated by Zhang in view of Gasper.

The Examiner alleges that the combination of Zhang and Gasper discloses or suggests all of the features of the claimed invention. Particularly, the Examiner alleges that Zhang discloses extracting a location of at least one blank area of a page. The Examiner acknowledges that Zhang does not disclose or suggest an invisible information recording method, and therefore, cites Gasper for this feature. The Examiner alleges that Zhang and Gasper would be combinable because they are in the same field of endeavor, and that it would have been obvious to combine them to maintain a high quality and utility of the document (e.g., see Office Action at pages 3-4).

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Applicant respectfully submits that, even assuming *arguendo* that Zhang and Gasper could be combined to arrive at the claimed invention, the ordinarily skilled artisan would not have been motivated (i.e., it would not have been obvious) to combine Zhang and Gasper to arrive at the claimed invention since Gasper teaches away from Zhang. Indeed, in view of such contrary teachings, Applicant submits that it would not have been obvious to modify Zhang and Gasper, absent the benefit of Applicant's own teachings (i.e., impermissible hindsight based analysis).

Thus, Applicant respectfully submits that it would not have been obvious to combine Zhang and Gasper, and therefore, traverses this rejection.

#### Zhang

For example, Zhang discloses printed matter 200 which includes a page 212 on which printed informational content 210 is printed (see Figure 1; see also Zhang at column 5, lines 51-67, and column 6, lines 1-19). Zhang discloses that the printed information content 210 can be text or an image located on the page 212.

Zhang discloses that the printed matter 200 further includes a print control symbol 214 made up of a plurality of bit characters 216. That is, Zhang discloses only one print control symbol 214.

Zhang discloses that the print control symbol 214 is preferably located at a predetermined position (i.e., only one position) on the page 212 (e.g., the upper left hand corner of the page 212).

Zhang discloses that, although it is not imperative that the print control symbol 214 be at a predetermined location, it is preferable that this be the case since a print control symbol 214 at a pre-determined location can then be found more quickly.

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However, in rejecting claim 13, the Examiner erroneously states that Zhang discloses a “plurality of locations that are selected to identify the medium”, citing Zhang at column 2, lines 34-44. However, neither the cited portion of Zhang at column 2, lines 34-44, nor any other portion of Zhang, discloses “a plurality”, as alleged.

Instead, Zhang merely discloses that the printed matter 200 further includes a print control symbol 214 made up of a plurality of bit characters 216. That is, Zhang discloses only one print control symbol 214, not a plurality of print control symbols.

Further, Zhang discloses that the print control symbol 214 is preferably located at a predetermined position (i.e., only one position) on the page 212 (e.g., the upper left hand corner of the page 212), not a plurality of locations.

#### Gasper

On the other hand, Gasper relates to media for restricting copying of a document utilizing one or more microdots that are embedded in the document for providing a non-visual, but machine detectable mark or marks. The detected means for detecting the presence of one or more microdots in the document inhibits a copy machine from copying the document (e.g., see Gasper at Abstract).

Gasper discloses that, in the preferred embodiment of the invention, the microdot pattern is incorporated throughout the document to be copy restricted. Gasper further discloses that microdot placement at all locations within the document insures that the pattern will exist in at least one important area of the document making it impossible to remove the pattern by physical cropping without significantly decreasing the usefulness of any copied document (e.g., see Gasper at column 6, lines 5-14). Gasper also discloses that the microdot pattern can be incorporated into the photographic medium prior to

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production of the photographic image (e.g., see Gasper at column 9, lines 38-46). That is, all of the medium would be printed with the microdot pattern.

On the other hand, Gasper also discloses that, in another preferred form of the invention, the microdot pattern is incorporated into the document in a pre-selected location or locations not covering the entire document (e.g., see Gasper at column 6, lines 5-14). Gasper does not, however, specifically disclose or suggest that the microdot pattern is recorded on a location of at least one blank area.

Applicant respectfully submits that, even assuming *arguendo* that Zhang and Gasper could be combined to arrive at the claimed invention, the ordinarily skilled artisan would not have been motivated (i.e., it would not have been obvious) to combine Zhang and Gasper to arrive at the claimed invention, since Gasper teaches away from Zhang. Indeed, in view of such contrary teachings, Applicant submits that it would not have been obvious to modify Zhang and Gasper, absent the benefit of Applicant's own teachings (i.e., impermissible hindsight based analysis).

For example, as mentioned above, Zhang discloses one print control symbol 214 located at a predetermined position (i.e., only one position) on the page 212 (e.g., the upper left hand corner of the page 212). Zhang discloses that, although it is not imperative that the print control symbol 214 be at a predetermined location, it is preferable that this be the case since a print control symbol 214 at a pre-determined location can then be found more quickly.

On the other hand, Gasper discloses a microdot pattern that is incorporated throughout the document to be copy restricted. Gasper further discloses that microdot placement at all locations within the document insures that the pattern will exist in at least one important area of the document making it impossible to remove the pattern by

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physical cropping without significantly decreasing the usefulness of any copied document (e.g., see Gasper at column 6, lines 5-14). Gasper also discloses that the microdot pattern can be incorporated into the photographic medium prior to production of the photographic image (e.g., see Gasper at column 9, lines 38-46). That is, all of the medium would be printed with the microdot pattern.

Thus, Applicant submits that it would not have been obvious to modify Zhang and Gasper, since Gasper teaches away from Zhang.

In other words, Zhang discloses one predetermined location for a single print control symbol 214 so that the print control symbol 214 can be found more quickly.

In contrast to Zhang, Gasper discloses placing a microdot pattern at all locations within the document to insure that the pattern will exist in at least one important area of the document making it impossible to remove the pattern by physical cropping without significantly decreasing the usefulness of any copied document.

Thus, Gasper's method of placing the microdot pattern at all locations within the document to insure that the pattern will exist in at least one important area of the document making it impossible to remove the pattern by physical cropping without significantly decreasing the usefulness of any copied document is contrary to the teachings of providing a single print control symbol 214 which can be found more quickly, as disclosed by Zhang.

Thus, even assuming *arguendo* that Zhang and Gasper *could* be combined to arrive at the claimed invention, the ordinarily skilled artisan would not have been motivated (i.e., it would not have been obvious) to combine Zhang and Gasper to arrive at the claimed invention, since Gasper teaches away from Zhang.

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Indeed, in view of such contrary teachings, Applicant submits that it would not have been obvious to modify Zhang and Gasper, absent the benefit of Applicant's own teachings (i.e., impermissible hindsight based analysis).

For the foregoing reasons, Applicant submits it would not have been obvious to combine Zhang and Gasper to arrive at the claimed invention.

Thus, Applicant submits that independent claim 1 and dependent claims 2-5, 13, 14, 18, and 19 are patentable over Zhang and Gasper, either individually or in combination.

**B. Claim 8:**

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang in view of Gasper, in further view of Bouldin, in further view of Dickerson.

Applicant submits that claim 8 is patentable over the cited combination of references at least by virtue of its dependency from claim 1, as set forth above.

**C. Claims 6 and 7:**

Claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zhang in view of Gasper, in further view of Yano.

Applicant submits that claims 6 and 7 are patentable over the cited combination of references at least by virtue of their dependency from claim 1, as set forth above.

**D. Claims 9-11:**

Claims 9-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zhang in view of Gasper, in further view of Cass.

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Applicant submits that claims 9-11 are patentable over the cited combination of references at least by virtue of their dependency from claim 1, as set forth above.

**E. Claim 12:**

Claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Zhang in view of Gasper, in further view of Cass, and further in view of Hayashi.

Applicant submits that claim 12 is patentable over the cited combination of references at least by virtue of its dependency from claim 1, as set forth above.

**F. Claim 15:**

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Boswell in view of Zhang, in further view of Gasper.

Applicant submits that independent claim 15 is patentable over the cited combination of references for somewhat similar reasons as independent claim 1, as set forth above.

**G. Claims 16 and 17:**

Claims 16 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Boswell in view of Zhang, in further view of Gasper, and further in view of Ur.

Applicant submits that claims 16 and 17 are patentable over the cited combination of references at least by virtue of their dependency from claim 15.

Applicant also submits that the Ur reference, which the Examiner relies on for teaching the step of extracting a plurality of locations of blank areas, does not disclose or suggest this feature.

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That is, contrary to the Examiner's position, Ur merely discloses a unique identifying code pattern 27, which may include some patterns (e.g., 27<sub>1</sub>) which are located at locations where they are clear of text 23. However, there is no affirmative step of extracting the blank locations, as recited in the claimed invention.

Instead, in Ur, a spaced apart pattern is selected merely to maximize the number of replications likely to appear in clear space on the document (i.e., to increase the chances or odds of appearing in the clear space)(e.g., see Ur at column 4, lines 10-12).

Indeed, Ur specifically acknowledges that a single pattern 27<sub>1</sub> can be printed at a location where it will be clear of the text 23. However, where the program prints selected matter other than printed text, such as, for example an image, there is no guarantee that any area on the document will always be free of selected matter 23 (e.g., see Ur at column 3, lines 60-67, and column 4, lines 1-12).

Because of this, Ur discloses that multiple replications 27<sub>1</sub> -27<sub>5</sub> can be printed at spaced apart locations across the face of the document 19 in order to maximize the number of replications likely to appear in clear space on the document (e.g., see Ur at column 4, lines 10-12). That is, the replications appear in the clear space by chance, not by affirmatively extracting the blank spaces of the page image of the sheet of paper, as claimed in claim 1.

In other words, Ur does not disclose or suggest extracting a plurality of locations of blank areas of a page image of a sheet of paper, as claimed.

Instead, Ur discloses selecting a spaced apart pattern in order to maximize the number of replications likely to appear in clear space on the document (i.e., to increase the chances or odds of appearing in the clear space)(e.g., see Ur at column 4, lines 10-12).

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Thus, Applicant submits that Ur does not make up for the deficiencies of Zhang and Gasper, with respect to independent claim 15. Therefore, the Examiner is requested to reconsider and withdraw this rejection.

#### H. Claims 20-22:

Claims 20-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang in view of Gasper, and further in view of Ur.

Applicant submits that claims 20-22 are patentable over the cited combination of references at least by virtue of their dependency from claim 1, as set forth above.

Applicant also submits that the Ur reference, which the Examiner relies on for teaching the step of extracting a plurality of locations of blank areas, does not disclose or suggest this feature.

As mentioned above, contrary to the Examiner's position, Ur does not disclose or suggest extracting a plurality of blank areas of a page image of a sheet of paper. Instead, Ur merely discloses selecting a spaced apart pattern in order to maximize the number of replications likely to appear in clear space on the document (i.e., to increase the chances or odds of appearing in the clear space)(e.g., see Ur at column 4, lines 10-12).

Thus, Applicant submits that Ur does not make up for the deficiencies of Zhang and Gasper, with respect to independent claim 1. Therefore, the Examiner is requested to reconsider and withdraw this rejection.

#### IV. CONCLUSION

In view of the foregoing, Applicants submit that claims 1-22, all the claims presently pending in the application, are patentably distinct over the prior art of record

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and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: February 23, 2006


  
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**CERTIFICATE OF TRANSMISSION**

I certify that I transmitted via facsimile to (571) 273-8300 the enclosed Amendment under 37 C.F.R. § 1.116 to Examiner Dillon J. Murphy, Art Unit 2624, on February 23, 2006.

  
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